

1                   RECORD OF ORAL HEARING  
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3                   UNITED STATES PATENT AND TRADEMARK OFFICE  
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6                   BEFORE THE BOARD OF PATENT APPEALS  
7                   AND INTERFERENCES  
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10                  Ex parte JEFFREY P. SZMANDA  
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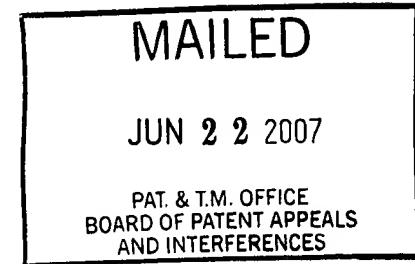
13                  Appeal 2007-0220  
14                  Application 09/982,640  
15                  Technology Center 2100  
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18                  Oral Hearing Held: May 23, 2007  
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Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and  
ALLEN R. MACDONALD, Administrative Patent Judges.

ON BEHALF OF THE APPELLANT:

CHARLES R. SZMANDA, ESQ  
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Westborough, MA 01581

The above-entitled matter came on for hearing on Wednesday, May  
23, 2007, commencing at 09:30 a.m., at The U.S. Patent and Trademark  
Office, 600 Dulany Street, Alexandria, Virginia.

1 JUDGE THOMAS: Good morning, sir. How are you?

2 MR. SZMANDA: Good morning.

3 JUDGE THOMAS: Have you been to the Board before?

4 MR. SZMANDA: I have never been to the Board before, sir.

5 JUDGE THOMAS: Okay. We give you 20 minutes, normally, for  
6 arguments.

7 MR. SZMANDA: Okay.

8 JUDGE THOMAS: You can use that clock as a guide, if you would  
9 like. We are kind of generally familiar with the record and the file and the  
10 disclosure, so you can proceed at your prompting.

11 MR. SZMANDA: Okay.

12 JUDGE MacDONALD: Introduce the --

13 JUDGE THOMAS: Yes. Your colleague, who should be  
14 introduced.

15 MR. SZMANDA: I will do that, sir.

16 JUDGE MacDONALD: I meant, we also have some other members  
17 of the Board and attorneys and interns, who are in the back. That it.

18 MR. SZMANDA: Well, good morning, Your Honors. Thank you  
19 very much for hearing me today. My name is Charles Szmanda. I am the  
20 agent who is appealing this case for my client, Mr. Jeffrey Szmanda, who is  
21 the founder of Madison Avenue Tools of Milwaukee, Wisconsin. He is an  
22 entrepreneur and business owner. His first product is a product called  
23 Moreaboutthisad.com, which is a product that searches the internet for -- or  
24 searches a database for the content of an advertisement.

1        In this appeal, claims 1, 11, 25, 39 and 42 are the independent claims  
2 under appeal. And they are rejected in view of Skillen, 6,098,065, and Loeb,  
3 6,421,652.

4        We have submitted arguments in our brief regarding the dependent  
5 claims -- several dependent claims, as well. These received no response  
6 from the Examiner in the Examiner's Answer. And so we ask that the  
7 appropriate action be taken under MPEP 1207.02, and also Ex parte M.

8        Let's look at claim 1. Claim 1 is a method of supplying  
9 advertisement information to a user searching for said information within a  
10 data network comprising the steps of receiving from the user a series of  
11 search rules comprising facts about an advertisement, and accessing a  
12 database comprising details of a plurality of advertisements, using a search  
13 engine to apply said search rules to said database, and reporting to the user  
14 the results comprising a subset of the contents of said database.

15       Now, receiving from the user a series of search rules comprising  
16 facts about an advertisement was defined for us by the Examiner.

17       However, my client has provided ample definition of the phrase and  
18 description of the phrase -- paragraph 35 of his application, the search rules  
19 can comprise key words or phrases describing the advertisement in some  
20 way. A description of the color schemes used in the advertisement, a  
21 description of music heard in the advertisement, visual cues perceived in the  
22 advertisement, a description of a plant, animal or human model or models  
23 used in the advertisement.

24       JUDGE MacDONALD: Excuse me. All of those are text queries?  
25       None of those are based on you selecting a color? They are all text-based?

1           MR. SZMANDA: They could be text-based or they could be entered  
2       in -- as a result of a question from, for example, the database itself.

3           JUDGE MacDONALD: Okay.

4           MR. SZMANDA: Or perhaps a description of the social situation  
5       depicted in the advertisement. Now, my client has further gone ahead and  
6       brought us Figure 7, where he actually shows an example of that. In Figure  
7       7, for example, the user is asked to write down what is remembered about  
8       the advertisement. And the user writes down a woman was climbing the  
9       stairs and walking fast. So, that is kind of an example of that.

10          Now, the Examiner has throughout prosecution -- every time we  
11       have answered one -- answered the Examiner's arguments based on a set of  
12       quotations from the Skillen or Loeb references, the Examiner simply comes  
13       up with some new quotations.

14          Finally, in the Examiner's Answer, three quotations from Skillen  
15       were proffered. I will not read them for you, but none of them have  
16       anything whatsoever to do with a user in Skillen inputting a series of search  
17       rules comprising facts about an advertisement. Those quotations, by the  
18       way, are in our brief and very easy to find.

19          Instead, Skillen's user is inputting anything. Nowhere in Skillen does  
20       it say anything about what the user inputs, except to say that the user is  
21       searching for information, in column 2, line 30 -- or desired information,  
22       from the Abstract, or column 1, lines 40, 51 and 59. Or in column 2, line 4,  
23       in claim 1.

24          In Loeb, the input that the user provides there is the result of a  
25       universal questionnaire. And the universal questionnaire solicits -- and I  
26       quote from Loeb -- "certain consumer information." That does not comport

1 with the ordinary meaning of advertisement information, and it certainly  
2 doesn't comport with the meaning --

3 JUDGE MacDONALD: Let me stop you there for a second. I am  
4 unclear why you are focusing on the information. How does that  
5 functionally change the database? I mean, I see in the claim --

6 MR. SZMANDA: The claim is, of course – the claim recites that the  
7 user inputs information about an advertisement that the database contains.

8 JUDGE MacDONALD: Again, but the functionality of the database  
9 -- I am assuming that this is an off-the-shelf database intended to store all  
10 kinds of information, any -- the developer of the database intended that to  
11 take any information you could come up with.

12 And the database was not modified in order to put the advertisement  
13 information into it, so I am trying to picture how these functions changed  
14 beyond it's a new type of information.

15 MR. SZMANDA: Well, the search engine may not change. The  
16 search engine may be standard kinds of -- may provide kinds of things. We  
17 describe that in the application. However, the database is specialized for this  
18 purpose.

19 JUDGE MacDONALD: In what way?

20 MR. SZMANDA: Well, the database, as it says in the claim,  
21 comprises details of a plurality of advertisements --

22 JUDGE MacDONALD: Again, it is the particular type of  
23 information.

24 MR. SZMANDA: A particular type of information. That is correct,  
25 sir.

1           JUDGE MacDONALD: But the software – the database software is  
2 -- sounds to be just off-the-shelf database software.

3           MR. SZMANDA: Yes.

4           JUDGE MacDONALD: The same as shown in the references.

5           MR. SZMANDA: It could be. But we are not claiming the software.  
6 We are claiming the specific kinds of information, and the --

7           JUDGE MacDONALD: Well, that being the --

8           JUDGE THOMAS: The patentability is predicated on the nature of  
9 the information?

10          MR. SZMANDA: Yes, sir.

11          JUDGE MacDONALD: Yes, and my concern there is that the case  
12 law is pretty specific, that that's it -- patentability has to be predicated on the  
13 structure or function. Not on information.

14          MR. SZMANDA: But in this particular case, the database -- in this  
15 particular case, sir, the data supplied to the user is the function. It is the --  
16 the result is that the user then obtains data regarding an advertisement.

17          This is not the structure of the information, it is the result of the  
18 search and the subset of the contents of the database that comes to it.

19          JUDGE MacDONALD: I am trying to picture how that changes the  
20 functions that are taught in the prior art, which are the user receives  
21 information of some kind.

22          MR. SZMANDA: Well, that is true. There are many examples --

23          JUDGE MacDONALD: Do you know what I'm saying? The  
24 information will be given --

25          MR. SZMANDA: -- examples where the user receives information  
26 of some kind.

1 JUDGE MacDONALD: Yes.

2 MR. SZMANDA: There are many examples of that. In this  
3 particular case, we are claiming a database which has certain information  
4 which is useful to the user.

5 JUDGE THOMAS: So what of claim 1 is not in the reference?

6 MR. SZMANDA: Neither reference teaches search rules comprising  
7 facts about an advertisement input by the user.

8 JUDGE MacDONALD: Can I stop you there, because I think you  
9 said -- you included things that are the reference in that statement.

10 MR. SZMANDA: Uh-huh.

11 JUDGE MacDONALD: The references teach search rules. The  
12 references do not teach advertising information.

13 MR. SZMANDA: That is correct.

14 JUDGE MacDONALD: Okay.

15 MR. SZMANDA: And neither -- I mean, neither references teaches  
16 details of a plurality of advertisements in the database. So, neither reference  
17 does that, either.

18 JUDGE THOMAS: So, let's clarify something from my point of  
19 view. Your position is that patentability is predicated on the fact that  
20 advertising information is in the database as opposed to generic kind of  
21 information.

22 MR. SZMANDA: Correct, sir. The rejection was based on 102, and  
23 our position is that the details of the claim are not taught in either of these  
24 references.

25 JUDGE THOMAS: What, all the details? Or just the one detail?

1           MR. SZMANDA: Well, the details in particular that we are talking  
2 about here today are the user inputs a series of search rules comprising facts  
3 about an advertisement, and accessing a database comprising details of a  
4 plurality advertisements. Those are the two elements which are not in the  
5 prior art, and which are taught and disclosed in my client's application.

6           JUDGE THOMAS: So, does the reference teach anything about  
7 searching a database by user inputs, do you?

8           MR. SZMANDA: Sure! Yes, sir.

9           JUDGE THOMAS: But your position is to key in on the fact -- the  
10 urging that it is not advertising information of some kind that is either stored  
11 or keyed in?

12          MR. SZMANDA: That is correct.

13          JUDGE THOMAS: That is the whole premise of this appeal?

14          MR. SZMANDA: Yes. If I understand your question correctly, the  
15 premise of this appeal is that the Examiner's rejections fail under 102,  
16 whether 102b or 102e, based on the fact that my client's claims are -- deal  
17 with specifically a series of search rules comprising facts about an  
18 advertisement, and accessing a database whose details -- comprising details  
19 of a plurality of advertisements.

20          JUDGE THOMAS: Okay. That helps the context of our  
21 consideration of the arguments in the record. All right?

22          MR. SZMANDA: Yes, sir.

23          JUDGE THOMAS: All right.

24          MR. SZMANDA: Thank you, sir.

1           JUDGE THOMAS: One other question while I have your attention.  
2 You asserted that the Examiner did not address any arguments presented as  
3 to the dependent claims in the Answer?

4           MR. SZMANDA: Yes. In our Reply Brief, we list all of the  
5 arguments that were dealt with in the Appeal Brief, and not addressed by the  
6 Examiner.

7           JUDGE THOMAS: Okay. So, you have repeated the arguments in  
8 the Reply Brief that were asserted in the Brief as to the dependent claims?

9           MR. SZMANDA: That is correct. Yes, sir.

10          JUDGE THOMAS: Okay. And furthermore, the Examiner did not  
11 respond in the responsive arguments portion of the answer to the arguments  
12 you made in the principal brief as to those dependent claims?

13          MR. SZMANDA: That is correct, sir.

14          JUDGE THOMAS: Okay.

15          MR. SZMANDA: Thank you. With regard to claim -- we will not  
16 spend a lot of time -- any more time on claim 1. I think you got the point on  
17 claim 1.

18          With regard to claim 11, the Examiner's rejections fail regarding  
19 claim 11, certainly on the basis of 102 -- because of claim 11 and 25,  
20 actually -- because claim 11 recites, inter alia, querying the user to obtain  
21 one or more search rules comprising facts about an advertisement, and then  
22 accessing a database comprising details of a plurality of advertisements, as  
23 before.

24          However, in claims 11 and 25, we also assert querying the user.  
25 Now, in this case, we do have a user query, in very much the same way, as  
26 we show in Figure 7 of my client's application.

1           However, Skillen, neither -- Skillen does not teach any kind of a user  
2 query. There is no query at all. In Skillen we see only that the user is  
3 inputting something at some time to a database. So, a user query isn't there.

4           Loeb, on the other hand, does have a user query, but in Loeb, the  
5 user query involves certain consumer information.

6           JUDGE MacDONALD: Can I ask you for clarification here?

7           MR. SZMANDA: Of course.

8           JUDGE MacDONALD: You are using the term "user query" and I  
9 am -- my understanding was in one situation it is a query by the user, and in  
10 another situation, it is a query of the user.

11          MR. SZMANDA: This is a query of the user.

12          JUDGE MacDONALD: Okay.

13          MR. SZMANDA: And specifically, sir, what we are talking about is  
14 the user sitting down, and, for example, encountering a screen that says,  
15 where did you see the ad. Did you see it on television, did you hear it on the  
16 radio, was it on a billboard. Tell us what you remember about the ad, and so  
17 on and so on.

18          So, the query of the user is what we are talking about here.

19          JUDGE MacDONALD: Of the user by the database?

20          MR. SZMANDA: By the database or by the software. Yes. That is  
21 correct. By the website.

22          And that is in claims 11 and 25. That is, of course, a very small  
23 distinction.

24          However, very small distinctions do frequently defeat anticipation  
25 rejections and I think it would do so here.

1           JUDGE MacDONALD: Is this on anticipation or an obviousness  
2 rejection? I thought it was obviousness.

3           MR. SZMANDA: In the case of the Skillen reference, the Examiner  
4 has rejected based on 102b. In the case of the Loeb reference, the Examiner  
5 has rejected claims 11 and 25 based on obviousness.

6           JUDGE MacDONALD: Okay. That's what I thought.

7           MR. SZMANDA: Okay. In that case, however, all of the claims are  
8 not taught or suggested at least, for example, the Loeb reference has a  
9 universal questionnaire which requests certain consumer information.

10          JUDGE MacDONALD: In the last five minutes, let me -- sorry to  
11 put you on the spot, but I think it is an important claim that you need to  
12 address, since this is a 103 rejection.

13          What is the impact, as you see it, of KSR on these claims?

14          MR. SZMANDA: I see no impact, sir. The KSR v. Teleflex case  
15 has to do with the question of whether there is a motivation to combine or  
16 modify. In this case, what we are claiming is that all of the claim limitations  
17 are not taught or suggested by the reference. In fact, that is manifestly true.  
18 So, KSR has no bearing on this case.

19          Claims 39 and 42 are the remaining two claims that are independent  
20 claims in this case. Claim 39 is a method of facilitating demographic  
21 research – a little bit different now -- by supplying advertisement  
22 information to a user searching for information on a data network, and so on.

23          And the claim recites receiving a set of search terms comprising  
24 words having targeted connotative significance to a particular demographic  
25 segment, and then accessing the database comprising details of a plurality of  
26 advertisements. Now, that is the rest of the claim.

1           We would like to focus on -- because we have already done this in  
2 the past arguments, we would like to focus on a set of search terms  
3 comprising – having targeted connotative significance to a particular  
4 demographic segment.

5           The concept of connotation has absolutely no appearance in Skillen  
6 or Loeb.

7           JUDGE MacDONALD: Could you tell us what you mean by that  
8 term?

9           MR. SZMANDA: Yes, sir. We define that on paragraph 18 of the  
10 application, but I am more than happy to tell you what I mean by the term.  
11 "Connotation" in the context of connotative meaning is that which carries  
12 more than the literal meaning of a term.

13           So that, for example, some -- let's use the word "score". We use that  
14 in the application. A score is literally the accumulation of points in a game.  
15 However, we also say that a person is said to "know the score". We also say  
16 that a person is said to have "settled the score", for example, when he  
17 extracts revenge for something.

18           So, the word can carry a great deal more meaning than the simple  
19 literal dictionary definition of the term. And different words have different  
20 connotative meanings to different demographic groups.

21           And that is exactly what we are talking about here. We are talking  
22 about the user using loaded words, words that are used by advertisers all the  
23 time. And mapping out particular demographic segments using those words.

24           So, claims 39 and 42 -- the rejections of claims 39 and 42 fail  
25 because neither Skillen nor Loeb contain anything related to connotation,  
26 and neither Skillen nor Loeb contain anything related to demographics and,

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1 furthermore, neither Skillen nor Loeb contain the relationship between the  
2 two. Paragraph 18 of my client's of my application -- if I said that, I am sorry  
3 -- does contain that, and it goes into some detail as to how that works.

4 So, for the reasons we have presented, we believe that the Examiner's  
5 rejections in this case, based on 102 and 103, should be reversed and we  
6 believe that my client's claims -- actually we solicit that action by this Court.

7 Thank you.

8 JUDGE THOMAS: Is there any other final comments or questions  
9 by the panel?

10 JUDGE MacDONALD: No.

11 JUDGE THOMAS: All right, sir. Thank you very much.

12 MR. SZMANDA: Thank you, sir.

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16 (Whereupon, the proceedings concluded.)